REMARKS

Status of the Claims

Claims 1, 3, 5-7, and 25-32 are currently present in the Application, and claims 1, 25, and 29 are independent claims. Claims 1, 25, and 29 have been amended, no claims have been canceled, and no claims have been added in this response.

Applicants are not conceding that the subject matter encompassed by claims 1-32, prior to this and previous amendments, are not patentable over the art cited by the Examiner. Claims 1, 25, and 29 were amended in this response solely to facilitate expeditious prosecution of this Application. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by claims 1-32 as presented prior to this and previous amendments, and additional claims in one or more continuing applications.

Examiner Interview

Applicants note with appreciation the telephonic interview conducted between Applicants' representative and the Examiner on September 9, 2009, as well as subsequent telephone conversations. During the telephonic interview, the Examiner and Applicants' representative discussed the 112 rejections and one of the 103 references (Nandigama, et al., U.S. Patent Pub. 2004/0010441). In particular, Applicants' representative discussed that some of the 112 rejections are improper and that Nandigama teaches away from using a different group of phase goals as claimed by Applicants. No agreement was reached regarding the claims.

Amendments to the Specification

Applicants have amended Applicants' specification in this response. As discussed with the Examiner, Applicants amendments are to clarify aspects of Applicants' invention that are already shown in Applicants' drawings. Therefore, no new matter is added with such amendments.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1, 3, 5-7, and 25-32 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse these rejections.

The Office Action states that the specification does not provide teachings for "creating or defining the particular phase goals themselves." Applicants note that Applicants' Figure 4, reference numeral 440, shows a step that a processor performs for creating phase goals. Applicants' specification on page 13, line 30 through page 14, line 5, states:

> "Processing generates phase goals for the selected product phase using the retrieved common metric at step 440. For example, if the retrieved common metric is "reliability", a "test phase" phase goal may include specific tests that include extensive test conditions to measure the performance and durability of a product."

Applicants' Figure 6 illustrates a computer system for performing such task. Applicants' specification on page 17, lines 19-21 states that "*Figure 6 illustrates information handling system 601 which is a simplified example of a computer system capable of performing the computing operations described herein.*" Furthermore, Applicants' specification on page 7, lines 10-12, states that Applicants' common metrics manager may "*represent an electronic computing device, such as a personal computer.*" Therefore, Applicants specification discloses a step for generating phase goals and a computer system capable of performing the step.

The Office Action states that the specification does not disclose "how it accomplishes" the generation of phase goals. Per MPEP 2164, Applicants are not required to disclose in detail exact steps to enable one of ordinary skill in the art. MPEP 2164 states:

> "The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation... The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue."

In addition, 2164.03 states:

> "The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art… The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. "

The Office Action, in its 103 rejection discussed below, states that Mendonca teaches the "generation" of a number of phase goals, therefore admitting that the prior art teaches the generation of phase goals. In addition, Applicants' novelty does not lie in the generation of phase goals themselves, but rather in the amount, or quantity, of phase goals that are generated based upon a weighted priority (see below for further discuss). Therefore, per MPEP 2164, since Applicants are not required to disclose in detail exact steps on how phase goals are generated, the 112, first paragraph rejection is improper and Applicants request the removal of this rejection to claims 1, 3, 5-7, and 25-32 in the next Office communication.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 3, 5-7, and 25-32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action includes three bullet statements under the 112, second paragraph rejection. Regarding the first bullet statement, Applicants have amended independent claims 1, 25, and 29 accordingly, and request removal of this rejection to claims 1, 3, 5-7, and 25-32 in the next Office communication. Applicants respectfully traverse the second and third bullet statements, which are discussed below.

Regarding the second bullet statement, the Office Action suggests that Applicants' independent claim 1 "omits essential steps" for generating a number of phase goals. MPEP 2172.01 states that essential matter is that which Applicants' specification describes as "necessary to practice the invention" and references MPEP 2164.08. Section 2164.08 states:

> "Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality."

Applicants' specification never states that the approach for generating phase goals involves critical steps. The generation may be performed through an algorithm, a lookup table, etcetera. Therefore, per MPEP 2164, this rejection is improper and Applicants request the removal of this rejection to claims 1, 3, 5-7, and 25-32 in the next Office communication.

Regarding the third bullet statement, the Office Action asserts that Applicants need to clarify how phase goals are determined and defined. Again, as discussed above, Applicants never state that the way in which the phase goals are determined is a critical function. Rather, Applicants' novelty lies in the number, or quantity of phase goals that are generated based upon the weighted priority. Applicants state:

> "Once the common metrics manager analyzes each customer feedback response and identifies a set of common metrics, the common metrics manager generates phase goals for each product phase in a product lifecycle using the common metrics. The number of phase goals generated for a common metric corresponds to the importance (i.e. ranking) of the common metric. For example, if a common metric has a highest weighted priority count relative to other common metrics, the common metric has the most number of corresponding phase goals for each product phase. For example, if a common metric is "reliability" and it has the highest weighted priority count, the common metrics manager may generate a substantial amount of reliability-related phase goals for each product phase." (page 4, lines 13-26, emphasis added)

As can be seen from the above excerpt, Applicants are not concerned with the way in which phase goals are generated, but rather the number of phase goals that are generated. Therefore, per MPEP 2164.08, Applicants are not required to include limitations regarding the way in which phase goals are determined and defined because Applicants never disclose that these are critical steps. Therefore, this rejection is

improper and Applicants request the removal of this rejection in the next Office communication.

Claim Rejections – Alleged Obviousness Under 35 U.S.C. § 103

Claims 1, 3, 5-7, and 25-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Corral (U.S. Patent Pub. 2003/0188290, hereinafter "Corral") in view of Nandigama, et al. (U.S. Patent Pub. 2004/0010441, hereinafter "Nandigama") in view of Vouk ("Software Reliability Engineering," hereinafter "Vouk") in view of Mendonca, et al. ("Validation of an Approach for Improving Existing Measurement Frameworks," hereinafter "Mendonca"). Applicants respectfully traverse these rejections.

Applicants have amended independent claim 1 to further describe that Applicants generate a number of phase goals that are dependent upon a common metric's weighted priority. Support for such amendment may be found in Applicants' specification, for example, in the paragraph on page 16, starting on line 10; Applicants' Figures 5A, 5B, and reference numeral 440 shown in Figure 4. Therefore, no new matter is added with such amendment. As amended, independent claim 1 is a computer-implemented method with limitations comprising:

- identifying a plurality of product phases that correspond to a product lifecycle;
- identifying a plurality of product phases that correspond to a product lifecycle;
- selecting a common metric from a plurality of common metrics, wherein the selected common metric is applicable to each of the plurality of product phases;
- identifying a weighted priority count for the selected common metric;
- computing a quantity value based upon the weighted priority count for the selected common metric, the quantity value corresponding to a number of phase goals to generate;
- utilizing a processor to generate a different group of phase goals for each of the plurality of product phases, wherein each of the different group of phase goals includes an amount of phase goals

that are equal to the quantity value and correspond to the common metric;

- applying the different group of phase goals for each of the plurality of product phases to their corresponding plurality of product phases; and
- executing each of the plurality of product phases using their corresponding different group of phase goals.

Applicants compute a quantity value of phase goals to generate (e.g., "8" phase goals) for a common metric based upon the common metric's weighted priority. Next, Applicants generate a different group of phase goals (each including an amount of phase goals equal to the quantity value) for each product phase. For example, "reliability" may be a common metric and its corresponding quantity value is "8." Continuing with this example, if there are three product phases, Applicants generate phase goals 1-8 for the first product phase, phase goals 9-16 for the second product phase, and phase goals 17-24 for the third product phase.

In contrast, the Office Action uses Nandigama to reject Applicants "different group of phase goals" limitations. The Office Action, on page 8, points to Nandigama's paragraph 5 to reject such limitation. After further review, however, Nandigama's paragraph 5 discusses drawbacks resulting from using different groups of phase goals, and actually teaches away from such limitation. Nandigama's paragraph 5 states:

> "Thus, even within the same organization, divisions having the same goals may choose different metrics to measure the progress towards the same goals. This lack of standardization is detrimental to the organization as the differing metrics can direct the divisions within the same organization down differing paths toward process improvement, thereby fracturing the organization rather than synchronizing the divisions."

As can be seen from the above excerpt, Nandigama criticizes and discredits the use of a different group of phase goals, thus teaching away from Applicants' limitation. As such, per MPEP Section 2145, it is improper to combine Nandigama with other references to reject Applicants' limitation. In turn, the Office Action has not established a prima facie case of obviousness and, therefore, Applicants' claim 1 is allowable over Corral in view of Nandigama in view of Vouk in view of Mendonca. Independent claim

25 is an information handling system claim that includes limitations similar to those found in independent claim 1 and, therefore, is allowable for at least the same reasons that independent claim 1 is allowable as discussed above. Independent claim 29 is a computer program product claim that includes limitations similar to those found in independent claim 1 and, therefore, is allowable for at least the same reasons that independent claim 1 is allowable as discussed above.

Each of claims 3, 5-7, and 26-28, and 30-32 each depend, either directly or indirectly, upon one of allowable independent claims 1, 25, or 29. Therefore, each of claims 3, 5-7, and 26-28, and 30-32 are allowable for at least the same reasons that their respective independent claims are allowable over Corral in view of Nandigama in view of Vouk in view of Mendonca as discussed above.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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